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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,229	02/09/2001	Hannu Tahkanen	032221-008	7229

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EXAMINER

SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,229

Applicant(s)

TAHKANEN, HANNU

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The list includes the Finnish patent specifications 79251 and 90019, as well as SCAN-CM40394.

Drawings

Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. ***Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.*** If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS. (not applicable)
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT. (not applicable)
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc). (not applicable)

The disclosure is objected to because of the following informalities: the above given format has not been followed. There are no sub-headings in this specification. Further, there is no summary of invention.

What appears to be the background summary (description of figures 1 and 2) is found in the latter half of the specification, and should be relocated to the beginning of

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the specification under "Description of the Related Art" in the background of the invention.

The text before the brief description of the drawings should be a concise summary of the inventive concepts and how these concepts improve over the art.

Appropriate correction is required.

Abstract

The abstract of the disclosure is objected to because an apparently meaningless "(Fig. 3)" appears at the end of it. Please delete this from the Abstract page. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites, in line 6, that pin chips separated in screening process are led among chips that are to be led to the subsequent process "without intermediate

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storage". The lack of enablement stems from the fact that none of the embodiments teach the chips being led to the subsequent process "without intermediate storage".

The doser 19 clearly "stores" the chips, even if only for a moment or two. The chips are inherently detained in the doser and lose velocity almost completely, if not completely, while passing therethrough. Thus, they are "stored".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following is a list of recitations without antecedent basis in the claims.

Claim 1, line 1: "the pin chips"

Claim 1, line 1: "the rest"

Claim 1, line 2: "the chips"

Claim 1, lines 2-3: "the share"

Claim 1, line 3: "the total amount"

Claim 1, line 4: "the pin chips"

Claim 1, lines 4-5: "the screening process"

Claim 1, line 5: "the chips"

Claim 2, line 1: "the amount"

Claim 3, line 1: "the amount"

Claim 3, line 3: "the amount"

Claim 4, line 1: "the amount"

Claim 4, line 3: "the amount"

Claim 5, line 2: "the amount"

Claim 5, line 2: "the sawdust"

Claim 5, line 3: "the chip pile"

Claim 6, lines 2-3: "the pin chips"

Claim 6, line 6: "the conveyors"

These above recitations must be removed from the claims, or alternatively, must be ascribed some antecedent basis in the claims. Please revise the claims to make these changes and insure that there are no other recitations putting forth elements using the terms "said" or "the" without first providing antecedent basis for such elements.

Claims 2-4 recite that an amount of pin chips dosed among other chips is "defined by". The term "defined by" does not evidence of the intent interpreted by the Examiner. Would not the term "determined by" or "set by" be more appropriate? In case Applicant feels that "defined by" is the most appropriate terminology, please provide an explanation. As currently appearing, these recitations are ambiguous, as "defined by" usually carries an existential connotation.

Claim 6, lines 4-5, recites "means... for dosing... the pin chips.... *Are placed* immediately after..." In this particular case, the "means" is actually a singular means in

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each embodiment. To say the "means (19, 19', 26, 28)... *are placed*" signifies that all of the disclosed means for dosing are incorporated into the same plant claimed in claim 6. Surely applicant does not wish to claim all of the different types of dosers in the same claim. Certainly this is not disclosed.

Thus, it will also assist in yielding more definite claims to remove the multiple reference numerals for the means, and if Applicant wishes to still ascribe the means a reference numeral, the Examiner requests that such be done on first mention of the means, so as to not allow a reader to think the means for dosing are different than the means firstly recited.

Lastly, the recitation "immediately after" signifies nothing in a patentable sense. No frame of reference, flow, etc. has been put forth that would lend the word "after" any meaning. "Immediately" does nothing in its own right, as this is a plant claim, thus "immediately" would require that there be absolutely nothing between the means and the screen (and/or conveyors), even a drop of several feet, a conveyor (one or the other, claimed in the alternative, only confuses the term "immediately after the screening devices or the conveyors"). If the dosing means is "immediately after" the dosing means while *not* precluding the existence of conveyors, then *which, of the conveyors and the dosing means*, is actually immediately after the screening devices.

In short, these claims must be completely re-written.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the group of references consisting of US 5,203,965 and WO 84/02093.

Due to the indefinite claims, it has been difficult to determine what is actually within the scope of the claims. Thus, the Examiner has tried to find references which relate to the novelty of the specification, and apply them as accurately as possible to the claims, in the Examiner's best interpretation of said claims, in light of the specification.

US 5,203,965 delivers mid-size chips to subsequent processing (30) from a screen (42) without any indication of "intermediate storage". As the wood chips are moved downwardly through hopper towards outlet 50, they will be in constant motion.

In WO 84/02093, the screen (54) passes chips to a digester without intermediate storage. The screen and the hopper combination can be interpreted as a doser, as it naturally feed a certain amount to the accepts belt while receiving much more in the top than it puts out the bottom. Alternatively, the accepts (28) are fed from the screening device (46) straight to the digester without intermediate storage, the screening outlet with conveyor shown is a doser in itself.

Claim Rejections - 35 USC § 102

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by admitted prior art. Figures 1 and 2 are admittedly prior art. These figures teach means for dosing the pin chips among chips to be led to subsequent process placed immediately after the screening devices. Further, there is no intermediate storage.

The Examiner suggest positively claiming the structure of the doser. The absence or presence of "intermediate storage" is not a patentable issue in this application, as one could argue that the doser of figure 1 never "stores" product, and one could also argue that the doser of figure 3 certainly does "store" product before dosing it. Certainly the walls (22) and (25) "store" chips, even if only momentarily.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703308 - 1113.

dks
September 26, 2002


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